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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,439	05/08/2002	Guy Serre	217415US0PCT	4236

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EXAMINER

HADDAD, MAHER M

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 04/09/2003

60

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/019,439

Applicant(s)

SERRE ET AL.

Examiner

Maher M. Haddad

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 5/08/02 and 9/30/02.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1644

### DETAILED ACTION

1. Applicant is reminded that “use” claims are non-statutory and are not appropriate for US practice (see MPEP 2173.05(q)).

For examination purposes, “use” claims are interpreted as method claims.

2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Two sequences appear on pages 12, lines 33-34 fail to comply with the sequence rule.

3. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1-3, 5, 7 and 10, drawn to a citrullinated polypeptide derived from all or part of the sequence of the  $\alpha$ -chain of a vertebrate fibrin, by substitution of at least one arginine residue with a citrulline residue, an antigenic composition, a kit and a kit thereof, classified in Class 530, subclasses 300 and 395 and Class 435, subclass 810.
- II. Claims 1-3, 5, 7 and 10, drawn to a citrullinated polypeptide derived from all or part of the sequence of the  $\beta$ -chain of a vertebrate fibrin, by substitution of at least one arginine residue with a citrulline residue, an antigenic composition, a kit and a kit thereof, classified in Class 530, subclasses 300 and 395 and Class 435, subclass 810.
- III. Claim 4, drawn to a method of diagnosing rheumatoid arthritis in vitro, using a citrullinated polypeptide derived from  $\alpha$ -chain; classified in Class 435, subclass 7.1.
- IV. Claim 4, drawn to a method of diagnosing rheumatoid arthritis in vitro, using a citrullinated polypeptide derived from  $\beta$ -chain; classified in Class 435, subclass 7.1.
- V. Claim 6, drawn to a method of detecting rheumatoid arthritis in a sample, using a citrullinated polypeptide derived from  $\alpha$ -chain; classified in Class 435, subclass 7.1.
- VI. Claim 6, drawn to a method of detecting rheumatoid arthritis in a sample, using a citrullinated polypeptide derived from  $\beta$ -chain; classified in Class 435, subclass 7.1.
- VII. Claim 8-9, drawn to a method of producing a medicinal product of a citrullinated polypeptide derived from  $\alpha$ -chain; classified in Class 435, subclass 7.1.
- VIII. Claim 8-9, drawn to a method of producing a medicinal product of a citrullinated polypeptide derived from  $\beta$ -chain; classified in Class 435, subclass 7.1.

Art Unit: 1644

4. Groups I and II are different products. Different polypeptides differ with respect to their structures and physicochemical properties; therefore each product is patentably distinct.
5. Groups III-VIII are different methods. A method of diagnosing, a method of detecting and a method of producing differ with respect to ingredients, method steps, and endpoints; therefore, each method is patentably distinct.
6. Groups I/(III, V and VII) and II/(IV, VI and VIII) are related as product and process of using. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides of Groups I and II can be used to make antibody, in addition to the methods of producing, diagnosing and detecting recited.
7. These inventions are distinct for the reasons given above. In addition, they have acquired a separate status in the art as shown by different classification and/or recognized divergent subject matter. Further, even though in some cases the classification is shared, a different field of search would be required based upon the structurally distinct products recited and the various methods of use comprising distinct method steps. Therefore restriction for examination purposes as indicated is proper.

#### *Species Election*

8. Irrespective of whichever group applicant may elect, applicant is further required under 35 US 121 (1) to elect a single disclosed species to which claims would be restricted if no generic claim is finally held to be allowable and (2) to list all claims readable thereon including those subsequently added.
    - A. If anyone of Groups I-VIII is elected, applicant is required to elect a specific citrullinated polypeptide (such as the full length, SEQ ID NO:1, SEQ ID NO:2 or peptides such as those on page 12, lines 33-34). These polypeptides are distinct species because their structures and modes of action are different.
- Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently.
9. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Art Unit: 1644

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

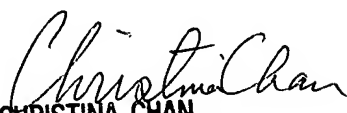
10. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maher Haddad whose telephone number is (703) 306-3472. The examiner can normally be reached Monday through Friday from 8:00 AM to 4:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Maher Haddad, Ph.D.  
Patent Examiner  
Technology Center 1600  
April 7, 2003

  
CHRISTINA CHAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600